

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kerry Zang et al.  
Serial No.: 10/777,514  
Filing Date: February 11, 2004  
Group Art Unit: 3738  
Examiner: Cheryl L. Miller  
Confirmation No.: 5263  
Title: CONICAL, THREADED SUBTALAR IMPLANT

**Mail Stop Notice of Appeal**  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following Pre-Appeal Brief Request for Review is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal.

### **REMARKS**

Previously, Applicants received a final Office Action dated November 4, 2009 (“*Office Action*”) and an Advisory Action dated February 8, 2010 (“*Advisory Action*”) rejecting each of the pending claims (e.g., Claims 40-44, 46-57, 62, 63, and 65-72) of Applicants’ Application. Applicants respectfully seek review of the rejections of Claim 67 and its dependent claim (e.g., Claim 68 and 69). Applicants do not seek review in this request of the rejections of Claims 40-44, 46-57, 62, 63, and 65-66, and 70-72.

#### **Section 103 Rejections**

The Examiner, under 35 U.S.C. § 103(a), rejects Claims 67-69 as allegedly being unpatentable over U.S. Patent Publication No. 2002/0038123 A1 by Visotsky et al. (“*Visotsky*”). Applicants contend that the rejections of those claims contain clear legal and factual deficiencies as described below. Accordingly, Applicants request a finding that the rejection of Claims 67 and its dependent claims (e.g., Claim 68 and 69) are allowable.

Claim 67 recites “at least one continuous and uninterrupted thread including a crest with a substantially flat surface and having a substantially constant thread height and helically traversing a length of an exterior surface of the body, the length spanning from the first end to the second end.” The Examiner relies on Figure 1 of *Visotsky* to reject the above-quoted limitations of Claim 67, arguing “(plurality of individual threads 41, each one being uninterrupted seen in fig. 1).” See *Office Action*, page 5, line 20 - page 6, line 1 (emphasis original). However, Figure 1 of *Visotsky* shows that its alleged thread is interrupted by a slot 50. See e.g., Fig. 1, Slot 50. As explained by *Visotsky*:

**Slot 50 of implant 10 is formed transversely through the implant.**

Slot 50 can be filled with autogenous bone, allogenic bone, xenograft bone, demineralized bone, bone paste, cellular material, growth factors, and the like to stimulate healing and remodeling of the implant within the fracture site.

*Visotsky*, paragraph [0027] (emphasis added). That is, *Visotsky* explicitly discloses that its alleged thread is interrupted by slot 50. Moreover, one of ordinary skill in the art would not be motivated to remove slot 50 from the device of *Visotsky* because doing so would eliminate that device’s ability to be packed with biologic materials, rendering it inoperable for its intended purpose of stimulating healing and remodeling of the implant within the fracture site as stated in the above.

While the Examiner seems to contend that the above-quoted limitations of Claim 67 are disclosed by a “plurality of threads,” “each one being uninterrupted;” see e.g., *Office*

*Action*, page 5, line 20 - page 6, line 1, Applicants respectfully point out that none of those alleged threads spans “from the first end to the second end” as recited by Claim 67.

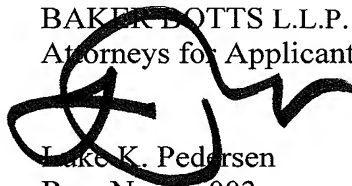
Since *Visotsky* does not disclose teach or suggest “at least one continuous and uninterrupted thread including a crest with a substantially flat surface and having a substantially constant thread height and helically traversing a length of an exterior surface of the body, the length spanning from the first end to the second end,” Applicants respectfully contend that Claim 67 and its dependent claims (e.g., Claims 68-69) are allowable over *Visotsky*.

**CONCLUSION**

As the rejections of Claims 67-69 contains clear legal and factual deficiencies, Applicants respectfully request a finding of allowance of Claims 67-69. If the PTO determines that an interview is appropriate, Applicants would appreciate the opportunity to participate in such an interview. To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to **Deposit Account No. 02-0384 of Baker Botts L.L.P.**

Respectfully submitted,

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